

Serial No. 10/516,084
Atty. Doc. No. 2002P07513WOUS

REMARKS

Claims 36-42 are pending in this application. The title of the application is objected to as being not descriptive. Claim 36 is objected to for informalities. Claim 36 is rejected under 35 USC 102(b) as being anticipated by Kajino. Claim 37 is rejected under 35 USC 103(a) as being unpatentable over Kajino in view of Ueda. Claims 38-42 are rejected under 35 USC 103(a) as being unpatentable over Kajino in view of Bast.

Objection to the Title:

The title has been amended herein to be more clearly indicative of the claimed invention.

Rejection of claims 36 and 37:

Claims 36 and 37 are cancelled herein.

Rejections of claims 38-42:

The applicants request reconsideration of the rejection of independent claim 38 in view of Kajino and Bast. The Examiner admits that the cited prior art fails to teach a monitoring structure comprising an electrical conductor attached to the heat shield at a distance equal to the critical length from the edge of the heat shield. To overcome this deficiency in the prior art, the Examiner relies on MPEP 2144.04, VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS and on MPEP 2144.05, H. OPTIMIZATION OF RANGES.

As discussed in MPEP 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Quoting from MPEP 2144.04, VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS, the Examiner relies on several court decisions; however, in each case the facts of the cited decision are not sufficiently similar to those in the pending application to provide a *prima facie* basis for the rejection under 35 USC 103. First, with respect to *In re Japikse*, the court decision found the invention to be unpatentable because the difference between the invention and the prior art "would not have modified the operation of the device."

Serial No. 10/516,084
Atty. Doc. No. 2002P07513WOUS

In contrast, the specifically claimed location of the monitoring structure in pending claim 38 is critically important to the proper operation of the claimed device. Thus, the facts of the Japikse decision are not similar to the pending application and the rationale of MPEP 2144.04 can not be used to provide the motivation necessary to support a *prima facie* case for obviousness. Similarly, the rationale of the cited *In re Kuhle* decision does not apply to the present application because that case involved a placement of a contact that was an obvious matter of design choice. In contrast, the placement of the electrical conductor of the monitoring structure of pending claim 28 is critical to the proper performance of the device, and thus a random location selected based upon a mere design choice would not provide the benefit of the present invention. Finally, the cited decision in *Ex parte Chicago Rawhide Mfg. Co.* reiterates the requirement of 35 USC 103 that "the prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference design." The Examiner has pointed to no column or figure of the cited prior art that provides such motivation. Accordingly, no *prima facie* case for obviousness has been established for the rejection of independent claim 38 under 35 USC 103 because the cited prior art is deficient in that regard and the cited case decisions are not sufficiently similar to the facts of the present application to provide a rationale to overcome the deficiency.

The Examiner has further relied upon case law cited in MPEP 2144.05, H. OPTIMIZATION OF RANGES. However, each of the cited decisions of *In re Aller*, *Peterson*, and *In re Hoeschele* all involve a range of variables (e.g. temperature range, acid concentration range, molecular weight or molar proportion range) disclosed by the prior art and an invention that is arguably obvious in light of those ranges of variables. In contrast, the prior art cited against claim 38 does not involve a range of such variables. The limitation in question is the position of the monitoring structure electrical conductor, and there is no corresponding range of positions that is disclosed in the prior art. Under 2144.05, a *prima facie* case of obviousness exists where "the claimed ranges 'overlap or lie inside ranges disclosed by the prior art.'" The applicants submit that MPEP 2144.05 is not applicable to the pending claim 38 since there is no range of a variables disclosed in the art nor is there a range of a variable included as a limitation of the claim. Accordingly, no *prima facie* case for obviousness has been established for the rejection of independent claim 38 under 35 USC 103.

Serial No. 10/516,084
Atty. Doc. No. 2002P07513WOUS

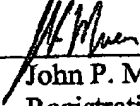
Conclusion:

Entry of this amendment and reconsideration and allowance of claim 38 and its dependent claims 39-42 are respectfully requested.

Respectfully submitted,

Dated: _____

By: _____


John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830